

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

Applicant(s): T.J. Gabara et al.

Case: 90-6

Serial No.: 10/668,544

Filing Date: September 23, 2003

Group: 2617

Examiner: Fred A. Casca

Title: Method and Apparatus for Automatic Determination of
Optimal User Device Location in a Wireless Network

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The remarks which follow are submitted in response to the present Supplemental Examiner's Answer, dated December 28, 2007, in the above-identified application. The present Supplemental Examiner's Answer contains arguments similar to those presented in the prior Examiner's Answer, dated January 3, 2007, which was held defective by the BPAI in an Order dated November 29, 2007. The present Reply Brief contains arguments similar to those presented in the prior Reply Brief, dated March 5, 2007, in response to the prior Examiner's Answer, dated January 3, 2007. The arguments presented by Appellants in the Appeal Brief, dated August 17, 2006, are hereby incorporated by reference herein.

Appellants will respond herein to certain arguments raised by the Examiner in Section 10, pp. 16-19, of the present Supplemental Examiner's Answer (hereinafter "Answer").

Claims 1 and 17-20

In Section 10(a), pp. 16-18, of the Answer, the Examiner continues to argue that Karaoguz describes the claimed limitation of “initiating a test of a communication link between at least one of the user devices and the access point, the test comprising a determination of data throughput performance” in independent claim 1 and 17-20, and that these claims are thereby anticipated by Karaoguz under 35 U.S.C. §102(e).

More specifically, on p. 16 of the Answer, the Examiner notes “that [the] specification does not describe what constitutes a ‘test of communication link’, what the ‘test’ involves and what steps are involved in the ‘test’. The specification only states that a test is initiated between at least one of the pluralities of user devices and an access point.” The Examiner uses this alleged lack of description in the specification to support a broad interpretation of the word “test.” In fact, the Examiner apparently concludes that a test is “merely a ‘question’ designed to determine knowledge.” Answer, p. 17. Based on this interpretation, the Examiner further reasons that “it logically follows that all that is necessary to meet the claimed limitation is a question regarding a communication link between an access point and a wireless device that includes or results in the ‘determination of data throughput performance’.” Answer, p. 17. This reasoning becomes the basis of the remainder of the Examiner’s arguments with respect to the independent claims.

Appellants respectfully submit that the above argument is untenable. Firstly, Appellants note that, in contrast to the Examiner’s characterization of the specification, the specification, in fact, provides substantial detail as to what may constitute a “test of a communication link” that comprises “a determination of data throughput performance.” At p. 8, l. 17-p. 9, l. 2 of the specification, for example, the specification states:

The test may be initiated upon access to the server(s) 108 connected to the access point device via network 106. For example, the test sequence may be specified in whole or in part using information retrievable by the user device or the access point device from server(s) 108 via the network 106. Such a test sequence may involve the transmission of a plurality of known packets at different bit rates between the user device and the access point device. The test sequence may be initiated by the user device, with the packets being transmitted to the access point device and returned from the access point device to the user device. As another example, the test sequence may be initiated by the access point device,

with the packets being transmitted from the access point device to the user device. Since the packet contents in this embodiment are known by the user device, the user device can compare the received packet contents to the expected packet contents in order to obtain measures of bit error rate. Packet bit rates can also be determined in a straightforward manner. The particular test sequences and the corresponding packet configurations utilized in a given embodiment may be based on conventional communication link testing techniques of a type well known in the art, and will therefore not be described in detail herein.

Secondly, MPEP §2111.01 requires that, during examination, a claim term must be given its “plain meaning unless the plain meaning is inconsistent with the specification,” where plain meaning means “the ordinary and customary meaning given to the term by those of ordinary skill in the art.” Based on this criteria, Appellants submit that one skilled in the art would interpret the claimed “test of a communication link” that comprises “a determination of data throughput performance” to be a sequence of explicit steps used to determine data throughput performance in a communication link rather than something less than that, as the Examiner appears to postulate. As argued by Appellants on p. 6 of the Appeal Brief, Karaoguz does not describe such a test. In Karaoguz the data rate of a user’s device is either embedded in a message sent by the wireless device to the configuration device or determined by reference to a lookup table or storage device. Karaoguz, paragraph 0038.

Claim 6

In Section 10(b), p. 18, of the Answer, the Examiner provides some general law concerning a motivation to combine Comp with Karaoguz. However, the Examiner does not provide any additional evidence of the existence of such a motivation in either reference beyond that which was provided previously. Appellants therefore respectfully maintain their assertion set forth on pp. 9 and 10 of the Appeal Brief that the §103(a) rejection of claim 6 is defective.

Claim 7

In Section 10(c), p. 18, of the Answer, the Examiner cites In re McLaughlin, 443 F.2d, 1392, 170 USPQ 209 (CCPA 1971), in arguing that the Examiner’s argument for a motivation to combine Kraft and Karaoguz does not use improper hindsight. Appellants note, however, that McLaughlin states that a “reconstruction based upon hindsight reasoning” is only proper “so long as it takes into

account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned from the applicant's disclosure." Id.

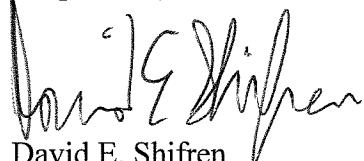
As argued on pp. 10 and 11 of the Appeal Brief, Appellants submit that, in formulating the §103(a) rejection of claim 7, the Examiner cites a motivation to combine references which finds its basis in advantageous aspects of the present invention rather than finding its basis in the proposed references or in the general knowledge of one skilled in the art. Appellants therefore submit that the Examiner is using "knowledge gleaned from the applicant's disclosure" when using hindsight to formulate the obviousness rejection of this claim. The use of such hindsight is improper according to McLaughlin.

Claim 8

In Section 10(d), p. 19, of the Answer, the Examiner further argues that claim 8 is anticipated by Karaoguz. However, this argument relies on the Examiner's assertions as set forth above with respect to independent claim 1, namely, that Karaoguz anticipates a "test" like that in claim 1. Appellants respectfully assert that Karaoguz does not describe such a test for the reasons set forth on pp. 5 and 6 of the Appeal Brief and for the reasons set forth above in this Reply Brief.

For the reasons identified above and in the Appeal Brief, Appellants respectfully submit that claims 1-20 are in condition for allowance, and respectfully request the withdrawal of the §§102(e) and 103(a) rejections.

Respectfully submitted,



David E. Shifren
Reg. No. 59,329
Attorney for Applicant(s)
Ryan, Mason & Lewis, LLP
90 Forest Avenue
Locust Valley, NY 11560
(516) 759-2641

Date: February 28, 2008